



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

HD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,066	06/06/2002	Kyle Ray Brown	102-1002	3163
24253	7590	04/24/2007		
JOEL I ROSENBLATT 445 11TH AVENUE INDIALANTIC, FL 32903			EXAMINER ZECHER, MICHAEL R	
			ART UNIT	PAPER NUMBER
			3609	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/24/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/064,066

Applicant(s)

BROWN, KYLE RAY

Examiner

Michael R. Zecher

Art Unit

3609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final, first Office Action on the merits. Claims 1-27 are pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show both path 16, which transmits authorized payments from the Success plan eCard holder, 21, to the Success plan provider system, 31, and the Success eCard sponsor, 47, as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 3609

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: both path 16, which transmits authorized payments from the Success plan eCard holder, 21, to the Success plan provider system, 31, and the Success eCard sponsor, 47, are described in the specification, but do not appear in the drawings. Appropriate correction is required.

Claim Objections

4. Claim 5 is objected to because of the following informalities: grammatical error. Claim 5 recites "...including an eCard containing data related said discount debt card..."; which should more appropriately be --including an eCard containing data related [to] said discount debt card...--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claim 19, the word "means" is preceded by various words including "containing, responsive, etc." It is unclear whether applicant is attempting to use a "means" clause to recite a claim element as a means for performing a specified

Art Unit: 3609

function. However, since the function specified by the word(s) preceding "means" is inconsistent, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claims 20-27 contains the same deficiencies, depend from claim 19, and are therefore rejected for being indefinite.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 8-15, 17-24, and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris et al. (U.S. 6,014,635) in view of Peirce et al. (U.S. 6,332,126).

As per claim 1, Harris et al. teaches a system for operating a discount debit card plan for processing of an eCard holder transaction by using a discount plan provider system responsive to the transaction amount reduced by a merchant discount and debiting the eCard holder with the transaction amount reduced by an eCard holder discount, and crediting the difference between the merchant discount and the card holder discount as at least one fee to the discount debit card plan provider or its affiliates, comprising:

a discount debit plan provider terminal containing data indicative of a discount debit card plan for use by participating merchants and for application to transactions

Art Unit: 3609

with a discount debit plan provider's authorized eCard (See column 3, lines 41-65, and column 4 lines 7-67, which discusses a discount credit system administrator, including a number of authorized merchants, whereby customers can passively or actively enroll);

a participating merchant terminal with merchant identifying information (See column 5, lines 29-60, which discusses how authorized merchants who agree to participate in the discount credit system are preferably connected to merchant banks which provide gateways into the VISA® credit network);

said discount debt plan provider eCard with eCard data, including eCard holder identifying data (See column 2, lines 18-28, which discuss how participants, upon passive or active enrollment, are assigned a membership number that is associated with a transaction card account issued by a card issuer);

a telecommunications network connecting said discount debit plan provider terminal and said merchant terminal for transmitting data between said terminals (See column 1, lines 35-45, which discuss the VISA ® credit transaction network, a standard computer network for transmitting authorization request).

said merchant terminal responsive to said eCard data and to transaction data for crediting said transaction made between said participating merchant and said eCard holder for transmitting said transaction data to said discount debit plan provider's terminal (See column 5, line 63 through column 6, line 37, which discusses a series of discount transaction processors which include a membership account issuing bank, a discount authorization processor, and a discount merchant bank);

said discount debit plan providers terminal responsive to said transaction data for debiting said eCard holder's account with eCard holder's discounted amount represented by said transaction amount reduced by said eCard holder's discount (See column 11, lines 50-53, which discuss how the value of the transaction minus the previously applied discount is credited to participants appropriate transaction card account). However, Harris et al. does not expressly disclose said discount debit plan providers terminal responsive to said transaction data for crediting said merchant's account with a merchant's discounted amount represented by said full transaction amount reduced by said participating merchant's discount.

Peirce et al. discloses a system and method for targeted payment discount utilizing bankcards to provide merchants with a flexible, cost effective method of advertising to a large number of interested consumers.

Both Harris et al. and Peirce et al. disclose systems and methods for offering discounted card transactions. Pierce utilizes merchant discounts within a credit transaction network to effectively and efficiently target offers deemed valuable to respective cardholders (See column 1, line 65, through column 2, lines 5, and claims 1-7 which discuss merchant discounts in the context of a discounted credit transaction). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Harris et al. to include a merchant discount for participation in a discount debit card system as taught by Peirce et al. in order to create a flexible, cost effective method for potential consumers to access various merchants (See column 1, line 50, through column 2, line 5, which discusses the desire for

Art Unit: 3609

merchants to find consumers interested in their products or services and the desire for consumers to have products or services they want or need at discount prices).

As per claim 2, Harris et al. teaches wherein said discount debit plan provider's terminal credits a difference between said participating merchants discounted amount and said eCard holder's discounted amount as at least one fee to said discount debit plan provider or its affiliates (See column 8, lines 42-52, which discuss a commission based on conventional formulas).

As per claim 3, Harris et al. teaches wherein, said discount debit plan provider's terminal is responsive to said transaction data for crediting said merchant and for debiting a source account of fungible funds for the amount credited to said merchant (See column 8, lines 29-33, which discuss how payments representing the gross amount of the purchase are withdrawn from an umbrella account which is housed at the membership account issuing bank and paid to the merchant bank) and for replenishing said source account from at least a part of said amount debited to said eCard holder's account (See column 8, lines 34-41, which discuss replenishing the umbrella account by settling with the participant's transaction card issuing bank).

As per claim 4, Harris et al. teaches wherein said debiting of said source account is made without identification of respective eCard holders fund placed in said source account (See column 8, lines 29-33, which discuss how payments representing the gross amount of the purchase are withdrawn from an umbrella account which is housed at the membership account issuing bank and paid to the merchant bank; no

Art Unit: 3609

identification of respective participants funds placed in the umbrella account takes place).

As per claim 5, Harris et al. teaches including an eCard containing data related [to] said discount debit card plan (See column 2, lines 18-28, which discuss how participants, upon passive or active enrollment, are assigned a membership number that is associated with a transaction card account issued by a card issuer); said merchant terminal responsive to said eCard, for transmitting to said discount debit plan provider's terminal, merchant identifying data for entry into said discount debit plan provider's terminal (See column 6, line 38 through column 7, line 67, which discusses how an authorization request is sent from the merchant bank to membership account issuing bank; the authorization request includes the membership account number and verifies that the request originated from an authorized merchant).

As per claim 6, Harris et al. teaches wherein said eCard includes sample transaction data and said discount debit plan provider's terminal, responsive to transaction data indicative of said sample transaction, denies the participating merchant credit for the said sample transaction (See column 9, lines 9-47, and column 10, lines 46-54, which discuss how a discount transaction is denied).

As per claim 8, Harris et al. teaches wherein said telecommunications network connects said discount debit plan provider's terminal to said participating merchant through an eCard company terminal (See Figure 1, specifically signals 24 & 25, which illustrates the discount transaction system including several data processors interconnected through a conventional VISA® transaction network); said eCard

Art Unit: 3609

company terminal responsive to said transaction data, transmits said transaction data to said discount debit plan providers' terminal (See Figure 1, specifically signals 22 & 23, which illustrates the discount transaction system including several data processors interconnected through a conventional VISA ® transaction network).

As per claim 9, Harris et al. teaches wherein said eCard company terminal responsive to said transaction data from said participating merchant's terminal, transmits data authorizing said transaction to said participating merchant's terminal (See Figure 1, which illustrates authorizing the transaction through signals 24 & 25).

Claims 10 and 19 recite equivalent limitations to claim 1, and are therefore rejected using the same art and rationale as set forth above.

Claims 11 and 20 recite equivalent limitations to claim 2, and are therefore rejected using the same art and rationale as set forth above.

Claims 12 and 21 recite equivalent limitations to claim 3, and are therefore rejected using the same art and rationale as set forth above.

Claims 13 and 22 recite equivalent limitations to claim 4, and are therefore rejected using the same art and rationale as set forth above.

Claims 14 and 23 recite equivalent limitations to claim 5, and are therefore rejected using the same art and rationale as set forth above.

Claims 15 and 24 recite equivalent limitations to claim 6, and are therefore rejected using the same art and rationale as set forth above.

Claims 17 and 26 recite equivalent limitations to claim 8, and are therefore rejected using the same art and rationale as set forth above.

Claims 18 and 27 recite equivalent limitations to claim 9, and are therefore rejected using the same art and rationale as set forth above.

10. Claims 7, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. in view Peirce et al. as applied to claims 1-6, 8-15, 17-24, and 26-27 above, and further in view of Barbara et al. (U.S. 2003/0105710).

As per claim 7, the Harris et al. and Peirce et al. combination discloses the structural elements of the claimed invention, but does not expressly disclose wherein, said discount debit plan provider's terminal, responsive to said merchant identifying data, registers said merchant as said participating merchant in said discount debit card plan.

Barbara et al. discloses a method and system for on-line payments that enables the making of payments using a credit card, checking account, or savings account (See paragraph 4 which discusses a method and system for making on-line payments utilizing a transaction account as a hub for such payments).

Both Harris et al. and Peirce et al. combination and Barbara et al. disclose methods and systems to make payments using electronic commerce. Barbara et al. discloses a quick enrollment aspect using pre-defined parameters within a method and system of making on-line payments utilizing a transaction account as a hub (See paragraph 27, which discusses how third party service provider executes pre-qualification base on pre-defined parameters, such as requiring customers of the third party to pay the service provider charges for using a credit card account). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

Art Unit: 3609

modify Harris et al. and Peirce et al. combination to include registering a merchant in the discount debit card plan based on pre-defined parameters as taught by Barbara et al. in order to provide a quick enrollment process (See paragraph 15, which discusses an advantage of providing a method and system for an on-line transaction that employs a quick enrollment process).

Claims 16 and 25 recite equivalent limitations to claim 7, and are therefore rejected using the same art and rationale as set forth above.

11. Although Applicant uses “means for” in claims 19-27, it is the Examiner’s position that the “means for” phrases do not invoke 35 U.S.C. §112 6th paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claims to remove all instances of “means for” from the claims, or to explicitly state on the record why 35 U.S.C. §112 6th paragraph should not be invoked.

Alternatively, if Applicant desires to invoke 35 U.S.C. §112 6th paragraph, the Examiner respectfully requests Applicant to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6th paragraph, the “means for” phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th ¶*. (Federal Register Vol. 65, No. 120, June 21, 2000.)

Failure by Applicant in their next response to address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant *NOT* to invoke 35 U.S.C. §112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding

Art Unit: 3609

discussion on 35 U.S.C. §112 6th paragraph applies to all examined claims currently pending.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ieshima et al. (U.S. 2003/0120590) discloses an electronic settlement method and system.

Thakur et al. (U.S. 2002/0194069) discloses business systems and methods for consumer/vendors interface via the internet to automatically provide discounts.

Kawan et al. (U.S. 6,978,250) discloses a system and method for automated electronic scrip transactions.

Hardesty (U.S. 6,105,865) discloses a financial transaction system with retirement saving benefit.

Wilcox et al. (U.S. 7,072,851) discloses a system and method for administering a credit card use incentive program by which a credit card holder earns rebate in the form of an additional payment toward an outstanding loan principal to reduce overall cost of the installment loan.

Fernandez-Holmann (U.S. 5,787,404) discloses a credit-card based retirement fund system and method.

Glaser (U.S. 2002/0056746) discloses an apparatus and method for facilitating credit transactions.

Art Unit: 3609

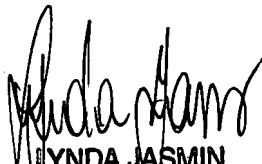
Weatherford et al. (U.S. 2002/0138343) discloses a method of providing merchant rebates to purchasers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Zecher whose telephone number is 571-270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRZ

 4/19/01
LYNDA JASMIN
SUPERVISORY PATENT EXAMINER